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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,044	02/25/2004	Yoel Cohen	26029	8550

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WASHINGTON, DC 20005

EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*ku*

**Office Action Summary**

Application No.

10/785,044

Applicant(s)

COHEN ET AL.

Examiner

Gary C. Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6-8,15,19-22 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,9-14,16-18,23-28 and 30 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/21/04 1/31/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species I in the reply filed on August 24, 2005 is acknowledged. However, Applicant erroneously included claim 15 (which is directed to Species VI) and claims 21 and 22 (which depend from non-elected claim 20). Accordingly, these claims are withdrawn from further consideration, as set forth immediately below.
2. Claims 3, 4, 6-8, 15, 19-22 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 24, 2005.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hook-and-pile arrangement recited in claim 27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the phrase "at least a portion circular portion" is not understood.

Regarding claim 11, there is no antecedent basis for "the data pad." It appears that claim 11 was intended to depend from claim 10, rather than claim 1. For examination purposes, claim 11 will be treated as if it did depend from claim 10.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 9-12, 14, 16-18, 23-25, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Babaz (WO 94/20309).

Babaz discloses a display aid comprising a user interface portion 17 and a handle mounting portion 5, wherein the handle mounting portion is deformable between a first position (Fig. 7) in which it is substantially flat and a second position (Fig. 8) where it is deformed so as to attach over a handle of a cart.

Regarding claim 2, see Fig. 8.

Regarding claim 3, the angled portions bounding opening 13 (Fig. 7) constitute a double-lobed portion, and the portion extending vertically from 5 (Fig. 7) constitutes a hook portion.

Regarding claim 12, the pad disclosed by Babaz consists of sheets of paper, which are erasable when written upon with a pencil.

Regarding claims 16 and 17, it has been held that although printed matter must be considered, where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401. In this case, there is no functional relationship between the printed matter and the substrate. Rather, the relationship of the substrate to the printed matter is merely that of support and display.

Regarding claim 18, the display aid disclosed by Babaz is rectangular, which is a common shape of commercial elements.

Regarding claims 24 and 25, see Fig. 7.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babaz (WO 94/20309) in view of Berrier (6,250,006).

Regarding claim 13, Babaz discloses the invention substantially as claimed, as set forth above. However, the pad disclosed by Babaz does not appear to include a partial preset list of items with a tic box associated with each item. Berrier teaches that it was known in the art to provide a pad for grocery shopping in which the pad includes a partial preset list of items with a tic box associated with each item. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pad disclosed by Babaz with a partial preset list of items with a tic box associated with each item, as taught by Berrier, in order to assist the user in keeping track of which items have been selected.

Regarding claim 26, Babaz discloses the invention substantially as claimed, as set forth above. However, the aid disclosed by Babaz is held against a support surface by a nail. Berrier teaches that it was known in the art to provide a sheet of magnetic material to the back of a display aid, for the purpose of allowing the aid to be conveniently displayed on a refrigerator. It

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would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the aid disclosed by Babaz with a magnetic sheet, as taught by Berrier, in order to allow the aid to be conveniently displayed on a refrigerator.

11. Claim 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Babaz (WO 94/20309) in view of Hockensmith (4,488,366).

Babaz discloses the invention substantially as claimed, as set forth above. However, the aid disclosed by Babaz is held against a support surface by a nail. Hockensmith teaches that a hook-and-loop arrangement is a functionally equivalent structure known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the aid disclosed by Babaz with a hook-and-loop arrangement, as taught by Hockensmith, in order to allow the aid to be displayed on a wall without having to punch a hole in the wall.

#### *Allowable Subject Matter*

12. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

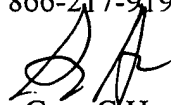
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch